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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,122	03/22/2002	Sunao Takatori	2222.6100001	9087

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WASHINGTON, DC 20005

EXAMINER

TINKLER, MURIEL S

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3691

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/089,122	Applicant(s) TAKATORI ET AL.	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. The status of the claims are as follows: claims 1-23 were previously pending; there are no amendments; no claims have been added; no claims have been cancelled; therefore, claims 1-29 are pending.

Response to Arguments

1. Applicant's arguments filed February 23, 2009 have been fully considered but they are not persuasive. The Applicant argues that the cited references do not teach: a transfer device configured to transfer money indicated by the monetary amount information; a transmitter configured to transmit the store ID information, the customer ID information and the monetary amount information; transferring money indicated by the monetary amount information; and, transmitting store ID information, the customer ID information and the monetary amount information. The Examiner disagrees:
2. Regarding the argument that the cited prior art does not teach: a transfer device configured to transfer money indicated by the monetary amount information; a transmitter configured to transmit the store ID information, the customer ID information and the monetary amount information; transferring money indicated by the monetary amount information; and, transmitting store ID information, the customer ID information and the monetary amount information: Chasko discloses this in figure 1 (element 112), figure 7a (element 706), figure 8 (element 806), figure 8a (element 858), figure 9 (element 906), figure 10 (element 1008), figure 11 (element 1104), column 7 (lines 49-67) and column 8 (line 1) through column 11 (line 50).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 24-27 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, the Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 11 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko (US 6,738,749 B1) in view of Joao et al. (US 6,047,270), hereafter referred to as Chasko and Joao respectively.

7. Claims 1, 4-6, 11 and 24-27 discuss an authentication management apparatus, comprising: storage means for storing a plurality of pieces of customer ID information and a plurality of pieces of store ID information; reception means for receiving a piece of customer ID information, a piece of store ID information, and amount information indicating a monetary amount from a store communication terminal; authentication means for authenticating the piece of customer ID information and the piece of store ID information that have been received by the reception means; and transfer means for transferring the monetary amount indicated by the amount information from an account

Art Unit: 3691

of a store with the authenticated piece of store ID information to an account of a customer with the authenticated piece of customer ID information. Chasko discloses:

- a storage means for storing a plurality of pieces of customer ID information and a plurality of pieces of store ID information in the Abstract, Background of the Invention, Summary of the Invention, figure 1 (element 112), figure (elements 221 and 232), column 4 (lines 27-48), column 5 (lines 1-48), column 7 (lines 49-67) and column 8 (lines 1-17 and 38-42);
- a reception means for receiving a piece of customer ID information, a piece of store ID information, and amount information indicating a monetary amount from a store communication terminal in figure 1 (elements 121, 124, 125 and 130), column 3 (lines 58-67) and column 4 (lines 1-10);
- an authentication means for authenticating the piece of customer ID information and the piece of store ID information that have been received by the reception means in the Field of the Invention, Background of the Invention, Summary of the Invention, figure 3 (element 308), figure 4 (element 358), figure 5 (element 504), column 3 (lines 50-57), column 4 (lines 27-63), column 5 (lines 20-40) and column 7 (lines 19-28).
- and a transfer means for transferring the monetary amount indicated by the amount information from an account of a store with the authenticated piece of store ID information to an account of a customer with the authenticated piece of customer ID information as the processing of transactions in the Field of the Invention, Background of the Invention, figure 1 (element 113), figure 7a (element 706), figure

Art Unit: 3691

8 (element 806), figure 8a (element 858), figure 9 (element 906), figure 10 (element 1008), figure 11 (element 1104), column 7 (lines 49-67) and column 8 (line 1) through column 11 (line 50).

8. However, Chasko does not disclose the use of a receiver configured to receive customer ID information from a mobile communication device. Joao teaches a receiver (central processing computer) configured to receive customer ID information from a mobile communication device in column 10 (lines 8-42). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Chasko to include the use of a mobile communications device because of added security (it allows informs the wireless owner when/how/where the device has been used without permission, see Joao column 10 [lines 43-59]).

9. Claim 2 discusses an authentication management apparatus in accordance with claim 1, wherein the receiver receives transfer source store account information and the transfer means transfers the monetary amount from an account indicated by the transfer source store account information received by the reception means. Claim 1 was rejected based on the discussion(s) above. Chasko discloses this in the Background of the Invention and column 10 (lines 61) through column 11 (line 23).

10. Claim 3 discusses an authentication management apparatus in accordance with claim 1, wherein the reception means receives cancel information from the store communication terminal and stops the transfer means from transferring the monetary amount. Chasko and Joao disclose the information in claim 1 see the discussion(s) above. Chasko does not specifically disclose the use of a cancel feature. Joao teaches

Art Unit: 3691

the use of a cancel feature in column 6 (lines 40-52). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a cancel feature to allow one of the parties to stop the transaction if desired.

11. Regarding claims 28 and 29, Chasko and Joao disclose the information in claims 1 and 4. See the rejection(s) of claims 1 and 4 above. While Chasko does disclose the use of a network (local area network), Chasko does not disclose the use of the Internet. However, Joao discloses the use of the Internet in communicating with mobile devices in column 4 (lines 44-58). Therefore, it would have been obvious to a person having ordinary skill in the art to modify Chasko's local area network to include the use of the Internet, because the Internet was old and well know in the art at the time the invention was made.

12. Claims 7, 12, 16 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Benton et al. (US 4,625,276 A).

13. Claims 7, 12, 16 and 20 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is a mobile communication terminal. Chasko and Joao disclose the information in claims 4-6 and 11, see the discussion(s) above. Chasko and Joao do not specifically disclose the use of a mobile terminal. Benton et al. teaches the use of a mobile terminal (portable module) in the Abstract, Technical Field, Background of the Art, Disclosure of the Invention, figure 1a, figure 1b, figure 2 and figure 4. Therefore it would have been

Art Unit: 3691

obvious to a person having ordinary skill in the art at the time the invention was made to use a mobile communications terminal to speed up account accessibility.

14. Claims 8, 13, 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Woolston (US 6,085,176 A).

15. Claims 8, 13, 17 and 21 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is set up in a pawnshop. Chasko and Joao disclose the information in claims 4-6 and 11, see the discussion(s) above. Chasko and Joao do not specifically disclose the use of a terminal at a pawnshop. Woolston teaches the use of a terminal at a pawnshop in column 5 (lines 53-67) and column 6 (lines 1-14). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a pawnshop because it is easily accessibly to the public.

16. Claims 9, 14, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Gustin et al. (US 6,012,048 A).

17. Claims 9, 14, 18 and 22 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is set up in a lottery money-exchanging booth. Chasko and Joao disclose the information in claims 4-6 and 11 see the discussion(s) above. Chasko and Joao do not specifically disclose the

Art Unit: 3691

use of a lottery money-exchanging booth. Gustin et al. teaches the use of a lottery money-exchanging booth in the Background of the Invention, Summary of the Invention, column 9 (lines 46-59), column 21 (lines 4-34), column 22 (lines 4-26 and 32-44).

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a lottery machine because lottery machines have a large volume of usage and because the purchase of end-user items is less susceptible to fraud, they do not require the additional security for transactions as cashing checks or money orders as discussed in Gustin, Background of the Invention.

18. Claims 10, 15, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko and Joao as applied to claims 4-6 and 11 above, and in further view of Fernandez (US 6,266,647 B1).

19. Claims 10, 15, 19 and 23 discuss a store communication terminal in accordance with any of claims 4-6 and 11, wherein the store communication terminal is set up in a prize-exchanging booth of a pachinko parlor. Chasko and Joao disclose the information in claims 4-6 and 11 see the discussion(s) above. Chasko and Joao do not specifically disclose the use of a pachinko parlor. Fernandez teaches the use of a Pachinko parlor in the Summary of the Invention, column 4 (lines 24-34 and 60-65), column 8 (lines 57-67), column 9 (lines 1-5) and claim 17. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a location that has pachinko games because it is easily accessible to the public.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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